

REMARKS

Reconsideration of presently solicited lithium battery Claims 1 and 4 to 6 respectfully is requested. For the reasons indicated hereafter, these claims are urged to be in condition for allowance.

Applicants have provided a lithium battery that incorporates an improved specifically-defined separator situated between the cathode and the anode. All of the presently solicited claims specify that the separator bears upon at least one of its surfaces a protective film of lithium nitride. See in this regard the highly advantageous results that are made possible as reported in Applicants' Example 1 at Pages 8 and 9 of the Specification.

The presence of the lithium nitride protective film on the separator retards the movement of a cathode active material and reduces undesirable self discharge and a reduction in the capacity of the battery. Such protective film of lithium nitride can be formed in accordance with the described process in the absence of deleterious pinholes, and displays excellent adhesion, flexibility, stability, strength, and very high ionic conductivity. See also the cell capacity information following the passage of time and discharge as reported in conjunction with Applicants' Example 1.

The continued rejection of presently solicited lithium battery Claims 1 and 4 to 6 as being anticipated under 35 U.S.C. §102(b) or rendered obvious to one of ordinary skill in the art under 35 U.S.C. §103(a) over the different teachings of U.S. Patent Nos. 6,025,094 and 6,413,284 or International Publication No. WO 01/33651 would be inappropriate. These publications are to the same assignee (i.e., PolyPlus Battery Company, Inc.), designate common named inventors, and portions of their disclosures with respect to the nature of the different barrier layer that is

contemplated are substantially identical. See for instance, (a) U.S. Patent No. 6,025,094 at Col. 4, lines 44 to 49 and Claims 4 and 33, (b) U.S. Patent No. 6,413,284 at Col. 3, lines 8 to 13 and Claim 7, and (c) International Publication No. WO 01/33651 at Page 3, lines 19 to 25 and Claims 8 and 50.

A typical teaching reads as follows, as taken from U.S. Patent No. 6,025,094 at Col. 4, lines 44 to 49:

The protective layer may include at least one of a lithium silicate, a lithium borate, a lithium aluminate, a lithium phosphate, a lithium phosphor nitride, a lithium silicosulfide, a lithium borosulfide, a lithium aluminosulfide, and a lithium phosphosulfide.

It respectfully is pointed out that the subject matter of Applicants' presently solicited Claims 1 and 4 to 6 is neither disclosed nor suggested. A protective layer of lithium nitride and the advantageous results made possible when lithium nitride is utilized are not revealed or otherwise contemplated in the cited publications. The subject matter of presently solicited Claims 1 and 4 to 6 is the contribution of Applicants and not that of the authors of the cited publications.

It is well established law that patentability is negated under 35 U.S.C. §102 only when the prior disclosure is identical to the invention sought to be patented. Each and every element of the claimed invention must be disclosed in a single reference in complete detail. See Akzo N.V. v. United States ITC, 808 F.2d 1471, 1 U.S.P.Q.2d 1241 (Fed. Cir. 1986); Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986); Rolls-Royce Ltd. v. GTE Valeron Corp., 800 F.2d 1101, 231 U.S.P.Q. 185 (Fed. Cir. 1986); Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 U.S.P.Q. 81 (Fed. Cir. 1986);

Great Northern Corp. v. Davir Core & Pad Co., 782 F.2d 159, 228 U.S.P.Q. 356 (Fed. Cir. 1986); In re Donohue, 766 F.2d 531, 226 U.S.P.Q. 619 (Fed. Cir. 1985); W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983); SSIH Equip. S.A. v. United States ITC, 713 F.2d 746, 218 U.S.P.Q. 678 (Fed. Cir. 1983); and Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989).

Finally, it is basic to the examination process that in order to establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. See M.P.E.P. §2143.03 in this regard. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494,496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. §103, then any claim dependent therefrom is nonobvious.

The withdrawal of the rejection is urged to be in order and is respectfully requested.

If there is any point that requires clarification prior to the allowance of the Application, the Examiner is urged to telephone the undersigned attorney so that the matter can be discussed and promptly resolved.

Respectfully submitted,

BUCHANAN INGERSOLL PC (INCLUDING ATTORNEYS
FROM BURNS DOANE SWECKER & MATHIS)

Date: February 1, 2006

By: *Benton S. Duffett Jr.*
Benton S. Duffett, Jr.
Registration No. 22,030

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620